

Applicants: Mark Ledeboer et al.
Application No.: 10/005,133

REMARKS

The Claim Amendments

Applicants have amended claims 1-6 and 20-21 and canceled claims 7-16 and 18-19. Applicants reserve the right to pursue the canceled subject matter in this application or in future continuing or divisional applications.

Applicants have amended claim 1 to clarify that an aryl or heterocyclyl group may be substituted and to recite suitable substituents for aryl, aliphatic or heterocyclyl groups. Support for this amendment may be found throughout the specification. See, e.g., page 11, line 21 to page 12, line 8. Applicants have also amended claim 1 to delete the proviso and to delete the recitation of "aryl" for R^2 . Applicants have amended claims 2-6 and 20-21 to improve their form. Applicants have also amended claim 6 (compound II-30) to correct a typographical error.

None of these amendments adds new matter. Their entry is requested.

The Response

The Rejections Under 35 U.S.C. §112, Second Paragraph

The Examiner states that claims 2-5 are rejected under 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner states that claims 2 and 3 lack antecedent basis because " CH_2 substituted heterocyclyl" and "substituted heterocyclyl" are not recited in the definition of R^2 and R^3 in claim 1. The Examiner further states that claim 1 does not allow for an optionally substituted heterocyclyl group. The Examiner also states that claims 4 and 5 lack antecedent basis because "benzyloxymethyl" does not fall within the group CH_2 (aryl) or " CH_2OR ". Applicants traverse.

The specification clearly states that an aryl or non-aromatic heterocyclyl group may be substituted. "An aryl group (carbocyclic or heterocyclic) or an aralkyl group, such as benzyl or phenethyl, may contain one or more substituents" (page 11, lines 21-23). Similarly, the specification states that a non-aromatic heterocyclic ring may contain one or more substituents (see page 12, lines 1-2). One having ordinary skill in the art

Applicants: Mark Ledeboer et al.
Application No.: 10/005,133

would also recognize that applicants intended to include optional substituents for aryl and heterocyclyl groups because originally-filed claims 4 and 5 recite that each of R^1 - R^3 is optionally substituted. In addition, one skilled in the art would recognize that applicants clearly intended that the term "aryl" include optional substituents because the specification recites numerous compounds wherein R^3 is a substituted aryl (see, e.g., compounds II-23 to II-50). Thus, originally-filed claim 1 encompassed optionally substituted aryl and heterocyclyl groups. However, solely to expedite prosecution, applicants have clarified claim 1 to recite the optional substituents on aryl, aliphatic and heterocyclic groups.

With respect to the specific rejection of claims 2 and 3, amended claim 1 clearly encompasses the substituents "CH₂substituted heterocyclyl" and "substituted heterocyclyl" for R^2 (R^3 does not recite these two terms). With respect to the specific rejection of claims 4 and 5, benzyloxymethyl clearly falls within -CH₂(aryl), wherein aryl is substituted by -OR and R is methyl.

The Rejections Under 35 U.S.C. §112, First Paragraph

The Examiner has rejected claim 1 under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. Specifically, the Examiner states that the added proviso in claim 1 does not have support in the specification.

Applicants have amended claim 1 to delete the proviso, thus obviating the rejection.

The Examiner has rejected claims 7, 9-16, 18 and 19 under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the enablement requirement. The Examiner states that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

Without acquiescing to the rejection, applicants have canceled claims 7, 9-16, 18 and 19, thus obviating the rejection.

Applicants: Mark Ledeboer et al.
Application No.: 10/005,133

The Rejection Under 35 U.S.C. §101


The Examiner has rejected claims 18 and 19 under 35 U.S.C. §101 as allegedly not being supported by either an asserted utility or a well-established utility.

Without acquiescing to the rejection, applicants have canceled claims 18 and 19, thus obviating the rejection.

Conclusion

Applicants request that the Examiner enter the above amendments, consider the accompanying arguments, and allow the claims to pass to issue. Should the Examiner deem expedient a telephone discussion to further the prosecution of the above application, applicants request that the Examiner contact the undersigned at his convenience.

Respectfully submitted,


Karen E. Brown
Reg. No. 43,866
Attorney for Applicants
c/o Vertex Pharmaceuticals Incorporated
130 Waverly Street
Cambridge, Massachusetts 02139
Tel: (617) 444-6168
Fax: (617) 444-6483